UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SURULIAPPA GOWPER JEGANATHAN, STEPHAN BIRY, PETER NESVADBA and DAVID GEORGE LEPPARD

Appeal No. 2005-1085
Application No. 09/806,360

ON BRIEF

Before GARRIS, HANLON and WARREN, Administrative Patent Judges.

HANLON, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 from the final rejection of claims 1-10, 12, 14 and 15, all of the claims pending in the application. Claims 1-10 are directed to a process for preventing the migration of oxidized developer in a color photographic material from one light sensitive silver halide emulsion layer to another silver halide emulsion layer using certain benzofuran-2-one compounds. Claim 12 is directed

to a color photographic material or digital recording material containing certain benzofuran-2-one compounds. Claims 14-15 are directed to certain benzofuran-2-one compounds and their use in stabilizing an organic material against deterioration by light, oxygen and/or heat.

The examiner relies on the following references:

Hinsken et al. (Hinsken)	4,325,863	Apr. 20, 1982
Birbaum et al. (Birbaum)	5,597,854	Jan. 28, 1997

The following rejections are at issue in this appeal:

(1) Claims 1-10 and 12 are rejected under 35 U.S.C. § 102(b) as being anticipated by Birbaum.

(2) Claims 14 and 15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Birbaum in view of Hinsken.

Grouping of claims

Appellants group the claims on appeal as follows (Brief, p. 4):

Group 1: Claims 1-10
Group 2: Claim 12
Group 3: Claims 14 and 15

Therefore, for purposes of appeal, the patentability of claims 2-10 stands or falls with the patentability of claim 1, the patentability of claim 12 stands or falls alone, and the patentability of claim 15 stands or falls with the patentability

of claim 14. See 37 CFR § 1.192(c)(7) (2003); see also 37 CFR § 41.67(c)(1)(vii) (2004).

Discussion

A. Rejection of claims 1-10

Claims 1-10 are rejected under 35 U.S.C. § 102(b) as being anticipated by Birbaum. Claim 1 is directed to a process for preventing the migration of oxidized developer in a color photographic material from one light sensitive silver halide emulsion layer to another silver halide emulsion layer containing color couplers comprising the "steps" of incorporating certain benzofuran-2-one compounds into an interlayer between the emulsion layers thus scavenging the oxidized form of developer when migrating from the emulsion layer in which it has been formed to the interlayer.

Birbaum discloses a novel composition comprising (A) an organic material which is sensitive to damage by light, oxygen and/or heat and (B) a compound corresponding to formulas I and Ia.[1] See col. 1, line 64-col. 2, line 19; col. 12, lines 27-48.

[1]The compounds of formulas I and Ia are not alleged to be benzofuran-2-one compounds within the scope of claim 1.

According to Birbaum (col. 20, lines 14-21):

> The compounds of the formulae I and Ia can advantageously be employed as stabilizers for organic materials against damage by light, oxygen or heat. These compounds are very particularly suitable as light stabilizers (UV absorbers). Organic materials to be stabilized can be, for example, oils, fats, waxes, cosmetics, biocides or photographic materials. Of particular interest is their use in polymeric materials, as are present in plastics, rubbers, paints or adhesives.

Birbaum discloses that the novel composition can include other stabilizers and provides an extensive list of fourteen classes of exemplary stabilizers. "UV absorbers and light stabilisers" are identified as the second class of stabilizers, and "Benzofuranones and indolinones" are identified as the fourteenth class of stabilizers. See col. 26, line 28-col. 28, line 27; col. 23, line 37-col. 29, line 51.

Birbaum discloses that the invention further relates to the use of a compound of formula I as a stabilizer against light damage, particularly UV light damage, in photographic materials. See col. 34, lines 25-30. The photographic material in Birbaum comprises, on a support, a blue-sensitive, a green-sensitive and/or a red-sensitive silver halide emulsion layer. In one embodiment, the novel material comprises a layer including a UV absorber of formula I arranged between the green- and red-

sensitive silver halide emulsion layers. See col. 34, lines 50-60; see also col. 35, lines 25-26 (the novel material preferably comprises gelatin interlayers between the silver halide emulsion layers).

Birbaum discloses that further UV absorbers, such as UV absorbers from the second class of stabilizers, can be combined with the compounds of formula I and employed in layers in the photographic material. See col. 34, lines 38-47; col. 34, line 66-col. 35, line 24. Birbaum does not mention whether benzofuranones are useful as further UV absorbers in the disclosed photographic materials.

Appellants recognize that Birbaum lists benzofuranones as optional stabilizers in the disclosed novel compositions. However, appellants argue that Birbaum does not disclose that benzofuranones are useful as optional stabilizers in the disclosed photographic material. Therefore, appellants argue that Birbaum does not anticipate the invention of claim 1.

As explained in In re Arkley, 455 F.2d 586, 587, 172 USPQ 524, 526 (CCPA 1972), a rejection based on anticipation is proper only when the claimed subject matter is identically disclosed or described in a prior art reference. See also Verdegaal Bros., Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053

(Fed. Cir.), cert. denied, 484 U.S. 827 (1987) ("A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."). Thus, for the instant rejection under 35 U.S.C. § 102(b) to be proper, Birbaum must clearly and unequivocally disclose the claimed invention or direct those skilled in the art to the claimed invention without any need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of Birbaum. Arkley, 455 F.2d at 587, 172 USPQ at 526.

In this case, Birbaum does not disclose that benzofuranones, either alone or in combination with the compounds of formula I, may be incorporated into an interlayer between silver halide emulsion layers in a photographic material as claimed. Therefore, we agree with appellants that Birbaum does not anticipate the invention of claim 1.

The examiner argues that one of ordinary skill in the art would have "envisaged" using a compound from any of the fourteen classes of stabilizers, including benzofuranones, in a photographic material as claimed based on the teachings of Birbaum. See Answer, p. 5.

To the extent that the teachings of Birbaum may have suggested incorporating a benzofuranone into an interlayer as claimed, this determination is properly made under 35 U.S.C. § 103, not 35 U.S.C. § 102(b). See In re Dow Chem., 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988) (criterion for determination of obviousness is whether the prior art would have suggested the claimed invention to one of ordinary skill in the art); see also Arkley, 455 F.2d at 587, 172 USPQ at 526 (picking and choosing may be entirely proper in making an obviousness rejection under 35 U.S.C. § 103, but it has no place in a rejection under 35 U.S.C. § 102 based on anticipation); Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983) (a prior art disclosure that "almost" describes the claimed invention may render the claim invalid under Section 103, but it does not anticipate the claim).

Based on the record before us, the examiner has failed to present a prima facie case of anticipation. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992) (the examiner bears the initial burden of presenting a prima facie case of unpatentability). Therefore, we are constrained to reverse the rejection of claim 1. Since claims 2-10 are

dependent on claim 1, we are also constrained to reverse the rejection of claims 2-10.

B. Rejection of claim 12

Claim 12 is rejected under 35 U.S.C. § 102(b) as being anticipated by Birbaum. Claim 12 is directed to a color photographic material or digital recording material containing a benzofuran-2-one within the scope of formula IV. For the reasons set forth in section "A." above, Birbaum does not describe a photographic material containing a benzofuranone.[2] See Arkley, 455 F.2d at 587, 172 USPQ at 526 (a rejection based on anticipation is proper only when the claimed subject matter is identically disclosed or described in a prior art reference). Therefore, we are also constrained to reverse the rejection of claim 12.

C. Rejection of claims 14 and 15

Claims 14 and 15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Birbaum in view of Hinsken. Claim 14 is directed to a compound within the scope of formula V.

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[2]The examiner does not allege that Birbaum discloses a digital recording material containing a benzofuran-2-one within the scope of formula IV. See Answer, p. 3.

The examiner relies on the teachings of Hinsken to establish that a compound meeting the limitations of the "present formula VI" would have been obvious. See Answer, p. 4.

Appellants argue that the rejection should be reversed because it is premised on the compounds of formula VI rather than the compounds of formula V.[3] See Brief, p. 6.

We agree. Since the examiner has failed to establish that the compounds of formula V, the only compounds recited in claim 14, are unpatentable, we are constrained to reverse the rejection of claim 14. See Oetiker, 977 F.2d at 1445, 24 USPQ2d at 1444 (the examiner bears the initial burden of presenting a prima facie case of unpatentability).

Claim 15 is dependent on claim 14. Therefore, we are also constrained to reverse the rejection of claim 15.

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[3]Appellants point out that the compounds of formula VI were removed from claim 14 in an amendment filed on November 13, 2002. See Brief, p. 6.

Conclusion

The rejection of claims 1-10 and 12 under 35 U.S.C. § 102(b) as being anticipated by Birbaum is reversed. The rejection of claims 14 and 15 under 35 U.S.C. § 103(a) as being unpatentable over Birbaum in view of Hinsken is also reversed.

REVERSED

BRADLEY R. GARRIS)
Administrative Patent Judge)
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ADRIENE LEPIANE HANLON) BOARD OF PATENT
Administrative Patent Judge) APPEALS AND
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